

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed June 14, 2005 ("Office Action"). At the time of the Office Action, Claims 1-34 were pending in the Application. In the Office Action, the Examiner withdrew Claims 10-34 as being directed to a non-elected invention and rejected Claims 1-9. Applicant amends Claims 1, 3, 4, and 5 and adds new Claims 35-45. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Section 102 Rejections

The Examiner rejects Claims 1-7 and 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2001/0032143 issued to Haseltine ("Haseltine"). Applicant respectfully disagrees.

Independent Claim 1, as amended, recites:

A method for processing the returns of merchandise purchased through the World Wide Web comprising:
identifying a user;
gathering transaction history data associated with the identified user from a computerized database;
displaying the transaction history associated with the identified user to the user on a computerized system, the transaction history identifying a listing of merchandise associated with the user; and
initiating a returns process in response to a selection, by the user, of an item of merchandise within the listing of merchandise in the transaction history, the selection comprising input into the computerized system.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the

claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *Haseltine* does not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicant respectfully submits that *Haseltine* does not disclose, suggest, or teach “displaying the transaction history associated with the identified user to the user on a computerized system, the transaction history identifying a listing of merchandise associated with the user,” as recited in Claim 1. With respect to Applicant’s step of “displaying”, the Examiner states that it is “inherent to show the returner what the terms of the return policy is at this point as questions are inherent in any such return process.” (Office Action, page 3). Based on the Examiner’s assertion of inherency, the Examiner admits that *Haseltine* does not *expressly* disclose the “displaying” step discussed above, but that it is merely *inherently* disclosed in *Haseltine*. However, the Examiner has not provided any reasoning to support this assertion of inherency.

The Examiner bears the initial burden of proof to establish inherency. *See* M.P.E.P. § 2112. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” M.P.E.P. § 2112.IV. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” M.P.E.P. § 2112 (*emphasis in original*).

Applicant respectfully submits that the Examiner, although relying upon the theory of inherency, has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from

the teachings of the *Haseltine* reference,¹ which is required to support a case of inherency. Accordingly, Applicant respectfully requests that the Examiner provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the *Haseltine* reference, purportedly supporting the Examiner's assertion of inherency.

In any event, Applicant respectfully submits that *Haseltine* fails to disclose, teach, or suggest, either expressly or inherently, "displaying the transaction history associated with the identified user to the user on a computerized system, the transaction history identifying a listing of merchandise associated with the user," as recited in Claim 1. To the contrary, *Haseltine* explicitly states:

The point-of-return associate 42 provides walk-in processing of the primary target's request for return. The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26. Again, the immediate message might actually be a web request for the download of the more full record of the packing slip. However gotten, the *point-of-return associate* calls up the electronic packing slip. Unlike most paper packing slips seen nowadays, this inventive electronic packing slip includes precise information if not instructions to the point-of-return associate. Such information or instructions will guide *this point-of-return associate* on how to properly authorize the return of the given product of this e-tailer.

(Page 3, paragraph 35, emphasis added). Accordingly, the system disclosed in *Haseltine* provides a return service by which a packing slip is received by a third-party mailing enterprise or other brick-and-mortar entity who then processes the return. There is certainly no reason to assume that the system disclosed in *Haseltine* necessarily operates in a manner or employs features that would disclose, teach, or suggest "displaying the transaction history associated with the identified user to the user on a computerized system," as recited in Applicant's Claim 1. Additionally, there is certainly no reason to assume that the system disclosed in *Haseltine* necessarily operates in a manner or employs

¹ Applicant makes no representation that *Haseltine* qualifies as prior art.

features that would disclose, teach, or suggest that “the transaction history identif[ies] a listing of merchandise associated with the user,” as recited in Applicant’s Claim 1.

Second, Applicant respectfully submits that *Haseltine* does not disclose, teach, or suggest “initiating a returns process in response to a selection, by the user, of an item of merchandise within the listing of merchandise in the transaction history, the selection comprising input into the computerized system,” as recited in Claim 1. As the basis for the Examiner’s rejection of Applicant’s “initiating” step, the Examiner states that “by initiating the return process to the associate 24, the user [of the *Haseltine* system] has thus selected the transaction displayed by the statement of the return policy of the e-tailer.” (Office Action, page 3). However, the Examiner acknowledges in the Examiner’s rejection of Claim 1 under § 103(a) that to the extent that *Haseltine* discloses the recited claim language “it does so in the context of the user being the point of return associate 42 rather than the customer.” Thus, the Examiner has acknowledged at least the failure of *Haseltine* to disclose “initiating a returns process in response to a selection, **by the user**, . . . the selection comprising input into the computerized system” in the context of Applicant’s Claim 1. Additionally, Applicant respectfully submits that *Haseltine* does not disclose, teach, or suggest “initiating a returns process in response to a selection, by the user, **of an item of merchandise within the listing of merchandise in the transaction history**,” as recited in Claim 1. Accordingly, Applicant submits that a continued rejection of Claim 1 under § 102 is improper in this case.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7 and 9 that depend from Claim 1.

Section 103 Rejections

The Examiner rejects Claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of U.S. Patent 6,321,211 issued to Dodd (“*Dodd*”). Applicant respectfully traverses these rejections for the reasons stated below.

First, Applicant has provided a detailed discussion of *Haseltine* above with regard to the Examiner's rejection of Claim 1 under 35 U.S.C. § 102(e). Because Applicant has shown above that *Haseltine* does not disclose, teach, or suggest each and every element of Applicant's Claim 1, Applicant has not provided further arguments regarding Claim 1 and *Haseltine* here.

Second, Applicant respectfully submits that the disclosure of *Dodd* does not make up for the acknowledged deficiencies of *Haseltine*. Specifically, Applicant respectfully submits that, like *Haseltine*, *Dodd* also does not disclose, teach, or suggest "initiating a returns process in response to a selection, by the user, of an item of merchandise within the listing of merchandise in the transaction history," as recited in Claim 1. To the contrary, *Dodd* merely discloses a system and method that provide "the ability for an online gift recipient to accept or exchange an online gift prior to shipping the gift to the recipient." (Abstract). In particular, "[a]fter a gift has been selected and the gift giver has provided contact information for the recipient . . . , web server 433a typically sends a notification message to the recipient" of the online gift. (Column 9, lines 28-31). After receiving the notification, "[t]he recipient then connects to the gift server computer system 330 through the Internet 412 and either manually provides an identifier to the web server 433a or the web server 433a automatically determines the identifier that links or associates the recipient with the appropriate order information on the selected gift." (Column 9, lines 35-41). According to the disclosure of *Dodd*, the webserver then displays one or more webpages to the recipient, which provide the recipient with details associated with the online gift and allow the recipient the options of accepting or exchanging the gift. (Column 9, lines 35-41; Column 11, lines 26-32; Figures 2A-2E). Thus, the recipient of an online gift merely clicks on one or more icons (Figure 2D, reference numeral 142; Figure 2E, reference numerals 144 and 145) to view the online gift and accept or exchange the online gift. There is no ". . . selection, by the user, of an item of merchandise within the listing of merchandise in the transaction history," as recited in Applicant's Claim 1.

Furthermore, *Dodd* explicitly discloses that the exchange system of *Dodd* is used by an online gift recipient “prior to shipping the gift to the recipient.” Accordingly, “[i]f the recipient wants to exchange the online gift for a replacement gift, the replacement gift is selected from a group of alternative gift items.” (Column 2, lines 6-9). “Once the replacement gift has been selected, an electronic order for the replacement gift is placed prior to physically receiving the online gift.” (Column 2, lines 10-12). *Dodd* provides such a system to avoid situations where “the recipient still must receive the gift and physically return it when they are not satisfied with the gift.” (Column 1, lines 47-49). Thus, the *Dodd* system actually teaches away from “initiating a returns process . . . of an item of merchandise within the listing of merchandise in the transaction history,” as recited in Applicant’s Claim 1.

Third, assuming for purposes or argument that the proposed combination discloses the limitations of Applicant’s Claim 1 (which Applicant disputes above), it would not have been obvious to one skilled in the art to make the proposed *Haseltine-Dodd* combination. In the Office Action, the Examiner speculates that “it would have been obvious to modify the method of *Haseltine* to include the user driven self return process of *Dodd* and to provide a selection step, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange etc.” (Office Action, page 5). Applicant respectfully submits, however, that the provided motivations do not provide a suggestion to combine these two references.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As discussed above, the very principle and purpose of the system disclosed in *Haseltine* is to provide “a distributed network of point-of-return affiliates who will accept the e-tailer’s

returns on a walk-in basis in such associate's brick-and-mortar store." (Page 2, paragraph 18). In contrast, the system of *Dodd* is designed to allow the recipient of an online gift the opportunity to select a replacement gift "prior to physically receiving the online gift" in an exchange transaction. (Column 2, lines 45-51). Thus, the very purpose of the *Dodd* system is to avoid situations where "the recipient still must receive the gift and physically return it when they are not satisfied with the gift." (Column 1, lines 47-49). Because the objectives of the *Dodd* and *Haseltine* systems are clearly inconsistent with one another, Applicant respectfully submits that one of ordinary skill in the art at the time of invention would not have been motivated to modify *Haseltine* in the manner proposed by the Examiner.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Haseltine* and *Dodd*, as identified by Applicant above, evidences the Examiner's reconstruction of Applicant's claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7 and 9 that depend from Claim 1.

Dependent Claim 8 depends upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claim 8 is not obvious over the proposed combination at least because Claim 8 includes the limitations of independent Claim 1.

Additionally, it continues to be Applicant's position that dependent Claim 8 recites elements that further distinguish the art. For example, Claim 8 recites "auctioning the merchandise selected for return by the user." Applicant respectfully submits that the Examiner has taken out of context that portion of *Haseltine* that discloses that "the problem with returns is that the customer and client may be separated by the entire breadth of the country making shipping for small products, e.g. cookies (paragraph 0026) non cost effective." (Office Action, page 5). Specifically, the portion of *Haseltine* relied upon by the examiner merely states that the "bar-coded packing slip is affixed by any suitable means to as much of the product that comprises a discrete, returnable unit." (Page 2, paragraph 26). As an example, *Haseltine* provides that "if the returnable unit comprises a box of cookies, then it is the box and not the cookies which are affixed with the bar code." (Page 2, paragraph 26). Accordingly, the portion of *Haseltine* relied upon by the Examiner does not provide the suggestion or motivation to modify *Haseltine* as the Examiner states. Certainly, *Haseltine* does not suggest that "it would be an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction," as suggested by the Examiner.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-9.

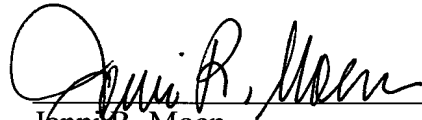
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

Applicant believes that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: December 14, 2005

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